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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/238,502	01/27/1999	YOSHIKAZU KOBAYASHI	Q52863	6211

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SUGHRUE MION ZINN MACPEAK AND SEAS  
2100 PENNSYLVANIA AVENUE NW  
WASHINGTON, DC 20037

EXAMINER

TRAN, CON P

ART UNIT	PAPER NUMBER
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2644

DATE MAILED: 11/18/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/238,502

Applicant(s)

KOBAYASHI, YOSHIKAZU

Examiner

Con P. Tran

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --.

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bayless (5,754,636, hereinafter, "Bayless") in view of Coad (5,966,652, hereinafter, "Coad").

Regarding **claims 1-4, 10, 12, and 14**, Bayless teaches a telephone call dialing method, for use in an information terminal with an operating system (see Fig. 20, 21, 22, 23, 25, 31, and respective portions of the specification), which can display a plurality of windows (see col. 21, lines 12-22), comprising the steps and means of:

selecting (e.g., using drag and drop) a string of character information in a window (e.g., file value window) displayed by the operating system, and storing (e.g., using drag and drop) the selected string of character information in a common working memory (e.g., database map window; col. 24, lines 12-14), which is shared by the operating system (see col. 15, line 62 – col. 16, line 3, col. 22, lines 35-43);

call dialing control means (558) for controlling the operation of call dialing based upon the telephone number output from the output means, to the line (see col. 36, lines 61-67).

selected piece of character information is stored in a common working memory (e.g., using drag and drop from file value to the database map window; col. 24, lines 12-14), which is shared by the operating system (see col. 15, line 62 – col. 16, line 3).

selected string of character information is one selected by a regional designation, and then stored in a common working memory (e.g., using drag and drop from file value to the database map window; col. 24, lines 12-14), which is shared by the operating system (see col. 15, lines 42-61).

Bayless also teaches to allow a user to import phone directories created for other applications using a text file wherein each line of the text file has a record to be entered and each field in the record is separated by a delimiter which may comprise, for example, a comma (Fig. 31, col. 23, lines 56-61); the information stored in custom dial plan window 262 can display dial string 278 that will be dialed when the user makes a call (Fig. 20, col. 21, lines 4-5). However, Bayless reference does not explicitly disclose to extract a telephone number from the stored string of character information.

Coad teaches a text parser 124 (Fig. 4) separates the call-back telephone number using the predetermined delimiters and stores the extracted call-back telephone number in the memory 116 (see col. 7, lines 32-37) in order to advantageously permit

the transmission of one or more embedded call-back telephone numbers that are embedded into a text message (see col. 3, lines 21-23).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate steps and means to extract a telephone number from the stored string of character information as taught by Coad with the Bayless in order to advantageously permit the transmission of one or more embedded call-back telephone numbers that are embedded into a text message as suggested by Coad in column 3, lines 21-23.

Regarding **claims 5-9, 11, 13, and 15-19**, Bayless teaches a telephone call dialing method, for use in an information terminal with an operating system (see Fig. 20, 21, 22, 23, 25, and respective portions of the specification), which can display a plurality of windows (see col. 21, lines 12-22), comprising the steps and means of:

displaying a first window (288; see col. 21, lines 40-67);

selecting (e.g., using drag and drop; col. 24, lines 12-14) a string of character information in a second window (282) displayed by the operating system on display application means (72), and storing (e.g., using drag and drop; col. 24, lines 12-14) the selected string of character information (see col. 22, lines 35-54) for assistance in controlling a call dialing operation (see col. 21, lines 40-67);

call dialing control means (558) for controlling the operation of call dialing based upon the telephone number output from the output means, to the line (see col. 36, lines 61-67).

selection means (64, 66) for selecting a string of character information in a second window displayed by the operating system (see col. 21, lines 40-50);

storage means (60, 62) for storing the selected string of character information (see col. 8, lines 42-48);

output means for outputting the telephone number in order to call-dial to a line (see col. 8, lines 6-14 and col. 21, lines 12-34).

entering a telephone number from the stored string of character information (see col. 22, lines 35-43);

displaying the telephone number in the first window (see col. 21, lines 40-67); and

call dialing based upon the telephone number, to a line (see col. 21, lines 4-11).

Bayless also teaches the information stored in custom dial plan window 262 can display dial string 278 that will be dialed when the user makes a call (Fig. 20, col. 21, lines 4-5). However, Bayless reference does not explicitly disclose to extract a telephone number from the stored string of character information.

Coad teaches a text parser 124 (Fig. 4) separates the call-back telephone number using the predetermined delimiters and stores the extracted call-back telephone number in the memory 116 (see col. 7, lines 32-37) in order to advantageously permit the transmission of one or more embedded call-back telephone numbers that are embedded into a text message (see col. 3, lines 21-23).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate with the Bayless reference steps and means to extract a telephone number from the stored string of character information; and call dialing based upon the extracted telephone number, to a line as taught by Coad in order to advantageously permit the transmission of one or more embedded call-back telephone numbers that are embedded into a text message as suggested by Coad in column 3, lines 21-23.

Regarding **claims 20 and 21**, Bayless in view of Coad further teaches the information terminal according to claim 11, wherein when the display application means sets the first window to a tool bar display form (see Bayless, col. 21, lines 40-50), the extraction means does not extract the telephone number from the character information (see Bayless, col. 19, lines 38-45).

Regarding **claim 22 and 23**, Bayless teaches a recording medium (60, 62; see Fig. 22, 24, 25, and respective portions of the specification), which stores a program to be executed by a computer, wherein the program includes:

- a procedure for displaying a first window (288), which assists a telephone call dialing operation (see col. 21, lines 40-67);

- a procedure for selecting (e.g., using drag and drop; col. 24, lines 12-14) a string of character information in a window displayed by the operating system, and

storing (e.g., using drag and drop; col. 24, lines 12-14) the selected string of character information (see col. 21, lines 35-50 and col. 22, lines 26-43);

a procedure for entering a telephone number from the stored string of character information (see col. 22, lines 26-43); and

a procedure for call dialing based upon the entered telephone number, to a line (see col. 21, lines 4-22).

Bayless also teaches the information stored in custom dial plan window 262 can display dial string 278 that will be dialed when the user makes a call (Fig. 20, col. 21, lines 4-5). However, Bayless reference does not explicitly disclose to extract a telephone number from the stored string of character information.

Coad teaches a text parser 124 separates the call-back telephone number using the predetermined delimiters and stores the extracted call-back telephone number in the memory 116 (see col. 7, lines 32-37) in order to advantageously permit the transmission of one or more embedded call-back telephone numbers that are embedded into a text message (see col. 3, lines 21-23).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate with the Bayless reference procedure to extract a telephone number from the stored string of character information; and call dialing based upon the extracted telephone number, to a line as taught by Coad in order to advantageously permit the transmission of one or more embedded call-back telephone numbers that are embedded into a text message as suggested by Coad in column 3, lines 21-23.



***Response to Arguments***

3. Applicant's arguments filed August 22, 2003 regarding claims 1-23 have been fully considered but they are not persuasive.

Applicant asserts on page 2:

"Bayless describes . . . The manual entry of telephone digits by a user does not correspond to *selecting a string of character information in a window displayed by the operating system.*"

Examiner respectfully disagrees. As presented above in the Office Action, Bayless teaches to allow a user to import phone directories created for other applications (col. 23, lines 56-61) using drag and drop from file value to the database map window (Fig. 31; col. 24, lines 12-14).

Applicant further asserts on page 3 :

"Consequently, Coad fails to teach and cannot possibly suggest *extracting a telephone number from the stored string of character information*, as recited in claim 1"

Examiner respectfully disagrees. As presented in the Office Action, Bayless in view of Coad teaches the above limitation (see Figure 4; col. 7, lines 32-37) since the obviousness is based on the incorporating of Coad teaching with Bayless.

Applicant further asserts on page 6 :

“Consequently, the Examiner has provided no reasonable suggestion or motivation, absent impermissible hindsight, to combine the teachings of Bayless and Coad.”

Examiner respectfully disagrees. As presented above in the Office Action, the motivation for incorporating Coad teaching with Bayless is from Coad. The relationship between the references is further noted as follows: a user of Bayless uses drag (i.e., select) and drop (i.e., store) to import a text file from file value window to database map window (Fig. 31). The text file has field records that are separated by delimiters such as commas. Netware import window (366) comprises telephone number format window (370; Fig. 32) in which the user may specify how many digits of a telephone number to be imported. Bayless does not explicitly disclose how to extract a telephone number from the stored string (e.g., pager). Coad teaches a text parser (124) that separates the callback telephone number by using the predetermined delimiters. Coad teaching enables one of ordinary skill in the art to incorporate a text parser with Bayless for purpose of permitting the transmission of one or more embedded call-back telephone numbers that are embedded into a text message (pager, Figure 21; col. 21, lines 20-22), as suggested by Coad in column 3, lines 21-23.

### ***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

Art Unit: 2644

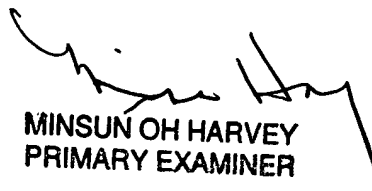
TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Con P. Tran, whose telephone number is (703) 305-2341. The examiner can normally be reached on M - F (8:30 AM - 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W. Isen can be reached on (703) 305-4386. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service Office at telephone number (703) 306-0377.

cpt CPJ  
November 12, 2003

  
MINSUN OH HARVEY  
PRIMARY EXAMINER